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| FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | EXAMINER DOONER, CHARLES | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1772 | |
| DATE MAILED: 04/19/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,018

Applicant(s)

MERRITT, JOHN

Examiner

Charles Dooner

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 6 and 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/23/04, 12/1/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed December 30, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Documents DE2035449 and FR1576587 have not been considered due to applicants failure to present English translations.

Specification

2. The use of the trademark "TYVEK 2FS" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

3. Claims 6 and 18 are objected to because of the following informalities: the term "spunbounded" in claims 6 and 18 is believed to refer to spunbonded.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The term "substantially surrounds" in claim 10 is a relative term which renders the claim indefinite. The term "substantially surrounds" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The degree at which a cavity is substantially surrounded is vague and can change depending on the application to which the package is used, therefore it does not distinctly point out what is claimed by the applicant. Appropriate clarification/correction is required.

6. Claims 2 and 3 recite the limitation "first material" and "second material" in Line 1 of each claim. There is insufficient antecedent basis for this limitation in the claim. Previously, it was labeled as "first sheet" and "second sheet". Appropriate clarification/correction is required.

7. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "at least two first sealing elements" and "at least two second sealing elements" are vague in that it is unclear if the "two first sealing elements" and the "two second sealing elements" can be the same or different. The claim is vague and therefore it does not

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distinctly point out what is claimed by the applicant. Appropriate clarification/correction is required.

8. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "overlap" is vague in that it does not distinctly point out the degree at which the two elements overlap. It is unclear as to whether the overlap is only at the edges of the two groups, or whether the two elements completely overlap one another with no single group occurring in the seal. Appropriate clarification/correction is required.

9. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "do not overlap" is vague in that it does not distinctly point out the degree at which the two groups do not overlap. It is unclear as to whether the two groups alternate in an A-B-A-B pattern in the seal so that no group touches the other or if the two groups form two separate seal lines so that the two groups form a continuous line. Appropriate clarification/correction is required.

10. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "associated" is vague and unclear since the term can be understood to have various meanings in regards to the claimed invention. Appropriate clarification/correction is required.

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11. Claims 8 and 19 contains the trademark/trade name TYVEK 2FS. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a spunbonded polyolefin and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claim 1, 3, and 9-17 rejected under 35 U.S.C. 102(b) as being anticipated by Hirt et al. (4630729).

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In regards to claim 1, Hirt et al. (4630729) discloses a package (Col. 3) Line 10) that consists of a sheet of plastic material (Col. 4, Line 39) and a non-paper material (paper like material) (Col. 4, Lines 41-43). The sheets are joined by sealing to form a joined region (Col. 4, Lines 43-45). These joined regions, consist of a first group of sealing elements (Col. 3, Lines 47-49) and a second group of sealing elements (Col. 3, Lines 61-63), define the receptive cavity in the package (59-62) that can receive an item, such as a surgical instrument, (Col 3. Lines 11).

In regards to claim 3, Hirt et al. (4630729) discloses that the package consists of two different materials, a sheet of plastic material (Col. 4, Line 39) and a non-paper material (paper like material) (Col. 4, Lines 41-43).

In regards to Claim 9, (Col. 4, Lines 41-43) The sheets are joined by sealing to form a joined region (Col. 4, Lines 43-45).

In regards to claim 10, Hirt et al. (4630729) discloses the seals of the package define the outer edge of the package. This inherently discloses that the seals defines the edge of the receptive cavity (Col 4, Lines 59-62), i.e. it substantial surrounds the cavity.

In regards to Claim 11, Hirt et al. (4630729) discloses joined regions, consist of a first group of sealing elements (Col. 3, Lines 47-49) and a second group of sealing elements (Col. 3, Lines 61-63). This inherently teaches the groups of sealing elements containing at least two elements since the term elements in Hirt et al. (4630729) is plural.

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In regards to Claims 12 and 14, Hirt et al. (4630729) discloses that the first group of sealing elements and the second group of sealing elements are uniformly distributed (dispersed) (Col. 3, Lines 17-24)

In regards to Claim 13, Hirt et al. (4630729) discloses that the first group of sealing elements are relatively small dimensions (Col 19-21).

In regards to Claim 15, Hirt et al. (4630729) discloses that the second group of sealing elements form an acute angle to the direction of the peel (Col. 4, Lines 16-19).

In regards to Claim 16, Hirt et al. (4630729) discloses that the first group of sealing elements are in the form of a net of thin lines, thus overlapping the elements of group 2 (Col. 5, Lines 21-23 and figure 2).

In regards to Claim 17, Hirt et al. (4630729) discloses that the first group of sealing elements are in the form of a dots, thus not overlapping the elements of group 2 (Col. 5, Lines 10-17 and figure 1).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 4-6, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirt et al. (4630729) in view of Brown et al. (5178277). Hirt et al. (4630729) describes a package with all of the limitations described above. Hirt et al. (4630729) also teaches the second group of sealing elements form an acute angle to the direction of the peel (Col. 4, Lines 16-19). Hirt et al. (4630729) fails to teach the material of the non-paper material as in Claims 4-7 or the material of the second sheet being spunbonded polyolefin as in claim 18.

In regards to Claim 4-6 and 18, Brown et al. (5178277) discloses the use of a spunbonded polyolefin as the non-paper material of claims 4-7 and the second sheet of claim 18 for the purpose of obtaining a breather pouch (Col. 1, Lines 32-42). Hirt et al. (4630729) and Brown et al. (5178277) are analogous art. -

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the package of Hirt et al. (4630729) with the spunbonded polyolefin of Brown et al. (5178277) in order to obtain a breather pouch.

16. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirt et al. (4630729) in view of Croft (5636497). Hirt et al. (4630729) describes a

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package with all of the limitations described above. Hirt et al. (4630729) fails to teach the first sheet and second sheet as being the same.

Croft (5636497) discloses a packaging material made from sheets of the same material, in this ca PVC (Col. 1 Lines 63-65) for the purpose of giving the package adequate seal strength (Col. 2, Lines 2-3) since Hirt et al. (4630729) and Croft (5636497) are analogous art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the two sheets of the package out of the same material in order to obtain an adequate seal strength.

17. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirt et al. (4630729) in view of Brown et al. (5178277) as applied to claim 4 above, and further in view of Wilkes (4367816). The package has all of the limitation as described above by Hirt et al. (4630729) in view of Brown et al. (5178277). The combined references fail to teach the spunbonded polyolefin as being uncoated.

Wilkes (4367816) discloses the advantage of an uncoated spunbonded polyolefin for the purpose of maintaining a good breathing rate (Col. 4, Lines 60-67) since since Hirt et al. (4630729) in view of Brown et al. (5178277) and Wilkes (4367816) are analogous art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use uncoated spunbonded polyolefin in order to maintain the good breathing rate of the spunbonded polyolefin.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Dooner whose telephone number is (571) 272-1646. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles Dooner
Patent Examiner
Art Unit 1772

4/17/06



HAROLD PYON
SUPERVISORY PATENT EXAMINER

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